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Paper No.

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**MAILED**

**AUG 11 2010**

**OFFICE OF PETITIONS**

In re Application of :  
Morgan et al. : DECISION ON PETITION  
Application No. 09/213,856 :  
Filed: December 17, 1998 :  
Atty Docket No.N0484.70331US00:

This is in response to the PETITION TO THE DIRECTOR OF THE USPTO UNDER 37 CFR 1.181, which is being treated as a (no-fee) petition to withdraw the holding of abandonment, filed July 16, 2006. This petition was recently forwarded to the undersigned for consideration. Subsequently, in the alternative, applicants filed a "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)" on January 12, 2009.

For the reasons stated herein, the petition under § 1.181 is **DISMISSED**.

Any request for reconsideration must be filed within **TWO (2) MONTHS**. This 2-month period is governed by 37 CFR 1.181(f) and is not extendable under 37 CFR 1.136.

By Notice of Abandonment mailed March 22, 2005, applicants were advised that the application was abandoned as a result of petitioner's failure to take appropriate action in a timely manner after the decision rendered on September 22, 2004, by the Board of Patent Appeals and Interferences (BPAI). Therefore, the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(c). As no claim was considered allowed, the application became abandoned.

Petitioner argues that, following the decision by the Board, a Terminal Disclaimer was filed on October 6, 2004. In short, petitioner indicates that given the filing of the terminal disclaimer and allowable subject matter being found in application No. 09/213,858, the examiner should have taken further action in this application.

Petitioner's arguments have been considered, and found quite persuasive. 37 CFR § 1.197(b) provides that:

- (1) Proceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except:
  - (i) Where claims stand allowed in an application; or
  - (ii) Where the nature of the decision requires further action by the examiner.

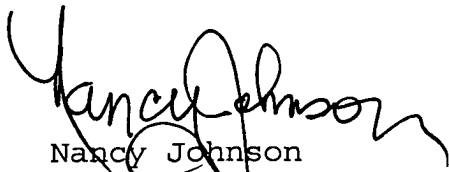
Further, pursuant to MPEP § 1214.06, paragraph II, when the time for seeking court review (plus 2 weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the examiner) has passed without such review being sought, the examiner must take up the application for consideration.

However, no terminal disclaimer filed October 6, 2004 (or thereabouts) is of record in this application. A review of the file contents and the file jacket does not support a conclusion that such a terminal disclaimer was filed in this application.

Proof of the timely filing of a proper terminal disclaimer which resolves the issues as argued by petitioner is necessary for a favorable decision on petition to withdraw the holding of abandonment. The petition is dismissed pending the submission of such proof (including a copy of the Terminal Disclaimer as originally filed including a certificate of mailing, or return postcard receipt evidencing its timely filing). Upon submission of such a terminal disclaimer, the petition under 1.181 will be reconsidered.

As this application filed December 17, 1998 became abandoned as a result of failure to timely seek court review of a BPAI decision, the Office will not consider the petition for revival under 37 CFR § 1.137(a). Applicants are not precluded from filing a renewed petition under 37 CFR 1.137(b).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a stylized flourish at the end.

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions